ATTACHMENT A
Remarks

Considering the matters raised in the Office Action in the same order as raised, claims 1-6 were rejected under 35 U.S.C. 102(b) as being anticipated by Peissig (US5517786). These rejections are respectfully traversed although, as explained in more detail below, independent claim 1, has been amended so as to more clearly define over the cited reference.

Turning to independent claim 1, the Peissig reference relied on in rejecting this claim discloses a heated "fishing rod" including a heated handle having an end cap, where said handle is mounted to the end of the rod shaft, a plastic cylinder, a plastic coated heat tape, a rechargeable battery pack, an on/off toggle button, an electronic regulator, a reel holder, a metal housed ceramic eyes and a tapered rod shaft.

Given the actual teachings of the Peissig patent, it is respectfully submitted that claim 1, as amended, patentably distinguishes over the Peissig patent. In independent claim 1, applicant claims a "golf club" including an electrically heated hand grip where said hand grip is inserted over an end of a golf club shaft. The heated handle of Peissig can not be inserted over the end of a golf club shaft because in Peissig, the heated handle is attached in series with an end of a shaft of the fishing rod, thereby lengthening the body of the apparatus and requiring a means to adapt the heated handle section in series with a shaft. Applicant contends that affixing a heated handle section of Peissig in series with a golf club shaft would lengthen the shaft of the club itself, thus, effecting both the swinging performance of a player and the balancing features of the shaft. In applicant's proposed invention, the shaft of the golf club does not have to be lengthened, sized or altered in order to accommodate a heated hand grip.

As recited in applicant's amended claim 1, the end cap assembly includes a receptacle having an electrical connecting means and a power source disposed therein and an electrical switch being disposed "on" said end cap assembly. The Peissig patent discloses an end cap, 12, which is fittingly

engaged to the handle section for providing containment of batteries, however, as shown in Figure 4, of the Peissig patent, the batteries are not completely disposed within the end cap but rather are contained in the handle section of the fishing rod. The end cap, in Peissig, is used to compress the power source within the housing of the handle section. Additionally, in Peissig, the switching means is disposed about the heated handle section and not "on" the end cap. Applicant recites an electrical switch which is disposed on an end cap assembly.

Both the power source and electrical components of applicant's invention are concentrated in one area, on the end cap assembly. This configuration provides various advantages. First, it allows for easy repair and replacement of both the power source, and the electrical switch without having to disturb the use of the golf club. Second, it removes any components that may be bothersome to the hands of an individual while holding the golf club. Third, it provides for a more compact, integrated hand grip, and fourth, in applicant's proposed invention, should the electrical switch or electrical connecting means fail or is in need of repair, the end cap assembly may be quickly replaced with another end cap assembly or a standard end cap, thereby allowing an individual to immediately use the golf club, unlike in the Peissig patent, where if the electrical switch fails, the entire fishing rod is placed out of commission while the electrical switch is being repaired or replaced.

In summary, the Peissig reference does not teach or suggest a golf club including an electrically heated hand grip inserted over an end of the shaft of the golf club, nor an electrical switch disposed "on" an end cap assembly. Accordingly, in light of amended claim 1, reconsideration of the rejection of claim 1 and allowance is respectfully solicited.

The claims which are dependent on claim 1 further distinguish the present invention from the heating fishing rod of the Peissig patent. For example, Claim 2, as amended, recites an inner sleeve including heat reflective properties, said inner sleeve being inserted over the end of a golf club shaft. The Peissig patent does not disclose an inner sleeve including heat reflective properties inserted over the end of a golf club shaft. In Peissig, the entire outer perimeter

of said heated handle section is wrapped with a handle heating means comprising a heating tape. Because there is no heat reflective properties recited in Peissig, some of the heat generated by the heating tape of Peissig may be thermally concentrated towards the interior of the inner hollow cylinder rather then towards the hands of a user. Examiner notes that Peissig is "inherently capable of heat reflecting property since all the heat can not be absorbed and some heat will be reflected". That is applicant's contention, the present invention is not to have "some" of the heat reflected, but all of the heated reflected towards a user's hands. To achieve this, the inner sleeve must have heat reflective properties so that all of the heat is reflected.

In view of the amendments made to claim 1, it is respectfully submitted that claims 3-5, which are dependent on amended claim 1, also be allowable for at least the same reasons as set forth above for the allowance of independent claim 1.

Regarding claim 6, Examiner notes again, that it is inherent to have etched foil or a carbon fiber heater as one of the components for a heating tape. Applicant traverses Examiner's comments and asks examiner to explain inherent as it pertains to heated members. Etched foil or carbon fiber heaters are very thin, delicate and costly. Using etched foil or carbon fiber heaters reduces manufacturing processes, allows for a more compact grip, saves time and space, but also increases the costs of the final product. Replacing ready available resistance heating wire with etched foil or carbon fiber heaters requires one to consider the costs, design, structure and manufacturing processes involved. Therefore, applicant contends that it is not inherent to replace electrical heating resistance wire with etched foil or carbon fiber heaters.

Claims 7-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Peissig (US5517786). These rejections are respectfully traversed. Regarding claims 7 and 8, applicant recites an end section including a plurality of threads externally formed thereon, and an end cap assembly having a plurality of threads internally formed within a sidewall member. In the Peissig patent, the hollow cylinder includes a plurality of threads internally formed therein and an

end cap having a plurality of threads externally formed thereon. The end cap assembly in the current application, includes a plurality of threads formed internally within a sidewall. Forming the threads internally within a sidewall allows the threads to be hidden from exposure, thus, reducing wear and tear and the chances of destroying or altering the threads making it more difficult to threadably attach the end cap assembly. Since the end cap assembly may often times be removed in order to replace or repair the power source or components, there is a strong likelihood that the end cap assembly will often times be dropped or placed in various locations, thus, increasing the risk of damaging the threads if such threads were formed externally on the end cap assembly.

Examiner contends that the Peissig patent shows an equivalent structure known in the art and that the recitation of claims 7-10 and the description of the Peissig patent are "art recognized equivalents" at the time the invention was made. Peissig states that, "the end cap is threaded and engaged thereto, in order to provide for a water-tight seal . . .". Peissig is designed such that if water slides down the handle, it will slide off the end of the handle and not enter any joint section that may have been formed when threading the end cap 12 onto the end of the heated handle. In Peissig, if the end cap 12 would have internally formed threads, then the end cap would have to be wide enough to thread over the end of the heating handle. Threading the end cap 12 of Peissig over the end of the heated handle would mean that a joint section would be established and as such, when water would slide down the handle, the water would be trapped in the joint section thereby not providing a water tight seal. Thus, it is not obvious to substitute one end cap having externally formed threads with an end cap assembly having internally formed threads because the use of one over the other will not provide for a water tight seal.

In view of the amendments made to claims 1, and 2, it is respectfully submitted that claims 7-10, which are dependent on said amended claim 1, be allowable for at least the same reasons set forth above.

Claims 1-13, 15-31 and 34-39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Peissig (US5517786) in view of Cornell

(US2003/0218007 A1). These rejections are respectfully traversed, although, as explained in detail above and again below, independent claims 1, 27 and 30 have been amended so as to more clearly define over the cited references and claims 13, 20, 26 and 37 have been cancelled.

Turning to independent claims 1, 27 and 30, the Cornell reference discloses a heating system for warming and drying the grip of a golf club. The heating system includes an electric heating element, an end cap including a first electrical connector, a golf bag including a power supply, a control system and a second electrical connector for engaging said first electrical connector in order to energize the heating element. In an alternative embodiment, the Cornell reference discloses a heating system for a grip of a golf club comprising a heating element, a housing formed within the shaft of a golf club for housing a portable power supply, wherein said power supply is electrically connected to a heating element so as to energize said heating element.

As recited by applicant, the application describes an end cap assembly having a power source disposed therein. As shown in Figure 19 of the Cornell reference, the power source is not disposed within the end cap assembly but rather, is disposed either within the shaft of a golf club or within a golf bag. Cornell teaches one or more batteries 692 that are received in a battery housing 690 that is positioned in the golf club shaft 614. The end cap 696 of Cornell, does not include a receptacle for having a power source disposed therein but merely is used to hold and/or compress the batteries within the battery housing. In Cornell, the power source is completely encased within the golf club shaft.

Placing a power source within the shaft of a golf club, limits the golfers performance because it requires the golfer to exhibit more energy in swinging the club so as to overcome the weight restrictions and balancing attributes of a golf club shaft. Since the battery housing is disposed within the shaft of a golf club, it would appear that the golf club shaft must be physically configured and designed to receive said housing, thus, requiring physical alterations and possible reengineering of golf club shafts for holding batteries.

Applicant contends that by placing the electrical components and power sources within the end cap assembly, there poses very little weight restrictions and misbalancing features of a shaft and requires no alterations or redesigns of standard shafts.

The Examiner contends that Cornell teaches an electrical switch (62) [Fig. 7 & 9, page 4, [0054], a power supply 60 and electric controls 62 electrically connected to the power supply, page 4, [0055]. A careful reading of both paragraphs teaches that the electric controls are included in the golf bag and does not teach that the controls are mounted on an end cap assembly.

Examiner notes that the Cornell patent teaches an electrical switch disposed about any one of a top member, sidewall member and outer sleeve and that, page 1, paragraph 8, of the Cornell reference, teaches a control system mounted in the base or elsewhere. Paragraph 8 states, "the second electrical connector is mounted to a base of the golf bag or elsewhere" and "a control system is mounted in the base or elsewhere in the golf bag for turning the power supply on and off, controlling the temperature and/or heating cycle, etc..". Examiner appears to suggest that the term "elsewhere" suggests that the Cornell reference teaches a control system mounted on a hand grip itself. Further, examiner correctly notes that the Cornell reference teaches a light emitting diode being electrically coupled to the electrical switch and the power source for indicating when the heating member is activated, however, page 1, paragraph 8, and paragraph 55, of the Cornell reference, teaches a control system mounted in the golf bag or elsewhere in the golf bag and that such controls may include on/off controls, and indicator lights. Thus, the indicator lights are mounted in the golf bag and not on the end cap.

The Cornell reference is silent as to placing controls directly on the hand grip of a golf club, except for a first connector, as indicated in [0011]. In fact, reviewing the several embodiments of the Cornell reference suggests the invention was designed and intended for placing the controls within the golf bag. Cornell appears to suggest that once the club is removed from the bag, the heating system is automatically activated by the first connector which is disposed

in the end cap. Thus, an individual cannot control the heating system at the hand grip itself.

Cornell does not teach nor suggest electrical controls including an electrical switch in the form of a variable resistance on/off switch, an on/off switch, an on/off timer or pulsing circuit, a timer switch, a thermostat switch, a potentiometer, a toggle switch, a dip switch a pushbutton and/or a slideable switch, where said electrical switch is disposed on the heated hand grip itself, and more specifically, on an end cap assembly. Cornell clearly recites that the controls are mounted within a golf bag. Placing the electric controls on the heated hand grip itself allows the user to have complete control of being able to turn on or off the heating member without reliance on a golf bag. In one non-limiting example, on many occasions a golfer strays away from the golf bag to walk a great distance with the golf club in his hands. With the electric controls on the hand grip itself, the golfer can control the heating member as he or she wishes without having to return to and depend on the controls within a golf bag in order to control the heating member.

Examiner contends that the end cap of the Cornell reference teaches an end cap including a receptacle for having a power source disposed therein and that the end cap includes a plurality of threads internally formed within said sidewall member. The applicant respectfully disagrees. The Cornell reference teaches an end cap 696 coupled to a battery housing so that the batteries can be replaced or accessed. The Cornell reference does not teach and end cap assembly including a receptacle for having a power source and electric components disposed therein. As seen in Figure 19 of the Cornell reference, the end cap 696 merely holds the battery within the housing in the golf club shaft. In addition, Cornell does not teach or show a plurality of threads internally formed within a sidewall member of the end cap assembly. As seen in Figure 19 of the Cornell reference, the end cap 696 includes a plurality of threads <u>externally</u> formed on the outer perimeter of the end cap. As noted earlier above, forming the threads internally of the end cap assembly means that the threads are hidden from exposure, thus, reducing wear and tear and the chances of destroying or

altering the threads thereby making it more difficult to threadably attach the end cap assembly.

Applicant contends that applicant's proposed invention provides a golf club including an integrated, compact, self-controlled, heated hand grip which includes local controls for controlling the supply of heat to the handle without reliance on a separate bag or apparatus for controlling the heating system of said hand grip.

Regarding claims 15-19, and 21-25, the Cornell reference does not teach the specific structures of an inner sleeve or an outer sleeve, nor does it teach the mechanical interconnection of said inner sleeve and said outer sleeve as recited in the claims. More specifically, claim 15 recites an inner sleeve including a plurality of hollow ribs, claim 17, recites and outer sleeve including a plurality of spaced channels, claim 21 recites an inner sleeve including a plurality of hollow stubs, and claim 23 recites an outer sleeve including a plurality of channels longitudinally formed within an interior surface.

Examiner has recited that Claims 15-20 and 23-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (US2003/0218007 A1) in view of Karner (US5870815). The examiner appears to include the Karner patent to address the issue of dimples, applicant's previous claim 14, but does not address the limitations of claims 15-20 or 23-26. Examiner does not recite claim 14 in the preamble rejection form paragraph, correctly so, since applicant had previously cancelled claim 14. For these reasons, applicant is confused as to why examiner would use the Karner reference to reject a claim that has already been cancelled in response to a first office action and does not address the particular claim limitations of claims 15-20 and 23-26. As described by applicant above earlier, the Cornell reference does not teach the recited elements in claims 15-20 and 23-26.

Examiner has recited that Claims 1-13, 15-31 and 34-39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Peissig (US5517786) in view of Cornell (US2003/0218007 A1), and that Claims 15-20 and 23-26 were

rejected under 35 U.S.C. 103(a) as being unpatentable over Cornell (US2003/0218007 A1) in view of Karner (US5870815).

MPEP 706.02(j)(C) and (D) notes that the examiner should set forth in the Office action: the proposed modification of the applied references necessary to arrive at the claimed subject matter and an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, to combine the reference teachings. The prior art reference(s) must teach or suggest ALL the claim limitations. In re Vaeck, 947 F.2d 488, [the teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure], Ex parte Clapp, 227 USPQ 972, [...or the examiner must present convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references].

Applicant contends that the examiner has not provided a proper explanation of the motivation for combining both the Pessig and Cornell references, nor for combining the Cornell and Karner references. The examiner has appeared to simply recite and stand alone, on particular elements of the Cornell reference to reject applicant's claims. The examiner has not provided the motivation for combining the heated fishing rod of Pessig with the Cornell patent, nor the Cornell patent with the Karner patent. Applicant contends that in light of MPEP 706.02(f)(C) and (D), the applicant has not been given a fair opportunity to reply.

Based on the foregoing discussions, applicant respectfully requests that the Examiner withdraw the rejection to claims 1-6 as being anticipated by the Peissig patent under 35 U.S.C. 102(b), that the Examiner withdraw the rejection to claims 7-10, as being unpatentable over Pessig under 35 U.S.C. 103(a), that Examiner withdraw the rejection to claims 1-13, 15-31 and 34-39 as being unpatentable over Pessig in view of Cornell under 35 U.S.C. 103(a) and that the Examiner withdraw the rejections to claims 15-20 and 23-26 as being

unpatentable over Cornell (US2003/0218007 A1) in view of Karner (US5870815) under 35 U.S.C 103(a).

In view of the amendments made to claims 1, 27 and 30 above, it is respectfully submitted that claims 2-12, 15-19, 21-25, 28, 29, 31, 34-36, 38, and 39 are in condition for allowance for the same reasons as set forth above.

It will be noted that applicant has cancelled claims 13, 20, 26 and 37.

In view of the foregoing, Applicant respectfully submits that the present application is in condition for allowance. Should the Examiner not find the application to be in condition for allowance, the Applicant respectfully requests that the Examiner telephone the Applicant in order to conduct a telephonic interview in order to expedite prosecution of this application and to move this application to allowance.

Respectfully submitted,

Vaughn Marquis

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